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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/713,516	11/14/2003	Michael Garfield	200189.00001	9976

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EXAMINER
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LEE, RIP A

ART UNIT	PAPER NUMBER
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1713

DATE MAILED: 09/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/713,516	Applicant(s) GARFIELD ET AL.	
	Examiner Rip A. Lee	Art Unit 1713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 21 June 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-11 and 13-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 26 is/are allowed.
- 6) ☒ Claim(s) 1-11, 13-15, 17-19, 22, 23, 25, 27 and 28 is/are rejected.
- 7) ☒ Claim(s) 16, 20, 21 and 24 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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### DETAILED ACTION

This office action follows a response filed on June 21, 2005. Applicants have amended claims 1, 2, 14, 15, 19, 21, 23, 25, 27, and 28. Claim 12 was canceled. Claims 1-11 and 13-28 are pending. The indicated allowability of claims has been withdrawn in view of the newly discovered references and reconsideration of the application.

#### *Claim Rejections - 35 USC § 102 / 35 USC § 103*

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. Claims 1-3, 5, 13-15, 17-19, and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by Miller (GB 2,223,023) for similar reasons set forth in the previous office action.

Briefly, Miller discloses a composition of matter comprised of SIS block copolymer, hydrocarbon resin, and aromatic and/or chlorinated hydrocarbon solvent. The composition of Example I contains 71 wt % of solvent system, 15 wt % of block copolymer, and 14 % of hydrocarbon resin. Trichloroethylene is used as the halogenated solvent, and according to Applicant's specification (page 5, paragraph [0017]), this solvent has no flash point, and thus, the solvent system would be deemed non-flammable. The hydrocarbon resin, which is derived from petroleum contains lower alkyls having 5-20 carbon atoms (*i.e.*, aliphatic C5 hydrocarbon resin) (page 8, lines 20-23).

3. Claims 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miller.

The patent is silent with respect to the rheological properties of the materials. However, in light of the fact that the claimed composition of Miller is essentially the same as that claimed in the present application, and in view of the fact that the material is fluid and may be applied by spraying, as is the case with the present composition, one of ordinary skill in the art would have found it obvious to believe reasonably that the composition of the prior art exhibits essentially the same physical properties recited in the claims. Since the PTO can not conduct experiments, the burden of proof is shifted to the Applicants to establish an unobviousness difference. *In re Fitzgerald*, 619 F.2d. 67, 205 USPQ 594 (CCPA 1980). See MPEP § 2112-2112.02.

4. Claims 1-5, 7, 13, 17-19, 22, 23, and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by Gaveske (U.S. 6,025,032) for similar reasons set forth previously.

Gaveske teaches a method and composition for waterproofing a substrate using a formulation comprised of organic solvent, hydrocarbon resin, and block copolymer. The solvent includes halogenated solvents such as methylene chloride, ethylene chloride, and trichloroethylene. According to Applicant's specification (page 5, paragraph [0017]), these solvents have no flash point, and thus, the solvent systems derived therefrom would be non-flammable. The block copolymer includes SEBS, SBS, and SIS block copolymers. The hydrocarbon resin is derived from petroleum streams, and the text discloses further that the hydrocarbon resin is derived from cationic polymerization of monomer(s) and may be hydrogenated to remove residual unsaturation. Use of polyterpene resins is also contemplated. The relative amounts of the three components are about 50-150 phr of organic solvent, about 25-35 phr of hydrocarbon resin, and about 10-15 phr of SEBS and SBS block copolymers. Use of pigments in the amount of about 0-10 phr is also disclosed.

5. Claims 9-11, 27, and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gaveske.

The patent is silent with respect to the rheological properties of the inventive materials. However, in light of the fact that (i) the composition of Gaveske is essentially the same as that claimed in the present application, (ii) the material is fluid and may be applied by spraying, as is the case with the present composition, and (iii) viscosity of some embodiments lies in the range of 5563-14300 mPa-s (equiv to cP-s; temperature not specified), one of ordinary skill in the art would have found it obvious to believe reasonably that the composition of the prior art exhibits essentially the same physical properties recited in the claims. Since the PTO can not conduct experiments, the burden of proof is shifted to the Applicants to establish an unobviousness difference. *In re Fitzgerald*, 619 F.2d. 67, 205 USPQ 594 (CCPA 1980). See MPEP § 2112-2112.02.

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Regarding claims 27 and 28, Gaveske indicates that the substrate to which the composition is applied is a structural unit such as a foundation, basement and retaining walls, and other building walls. The waterproofing composition is applied by spraying, and this requires a flowable composition of appropriate viscosity. Upon application to a substrate (*i.e.*, a wall), the composition is allowed to dry for about 4-24 hours so that the solvent is removed. Although the term "evaporation" is not used in the patent, clearly, evaporation is the operative mechanism. Thus, the process steps of mixing hydrocarbon resin and rubber component in a chlorinated organic solvent system, spraying, and evaporation is disclosed adequately, and one of ordinary skill in the art would have found it obvious to arrive at the manipulative features of claims 27 and 28 based on the prior art.

6. Claims 1, 3-6, 8, 13, and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Lehman (U.S. 4,970,242).

Lehman discloses a non-flammable composition comprised of 10-75 wt % of solvent (trichloroethane), and 0.1-10 wt % of butadiene-styrene rubber, and 0.5-5 wt % of tackifying (coumarone-indene) resin (claims 1, 3, 4, and 6). Corrosion inhibitor is also incorporated into the composition (table, column 4), and this qualifies as "stabilizing agent." Other solvents such as perchloroethylene (ethylene tetrachloride) and methylene chloride may be used (col. 3, line 41).

7. Claims 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lehman.

The patent is silent with respect to the rheological properties of the materials. However, in light of the fact that the claimed composition of Lehman is essentially the same as that claimed in the present application, and in view of the fact that the material is fluid and sprayable, one of ordinary skill in the art would have found it obvious to believe reasonably that the composition of the prior art exhibits essentially the same physical properties recited in the claims. Since the PTO can not conduct experiments, the burden of proof is shifted to the Applicants to establish an unobviousness difference. *In re Fitzgerald*, 619 F.2d. 67, 205 USPQ 594 (CCPA 1980). See MPEP § 2112-2112.02.

8. Claims 16, 20, 21, and 24 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The above claims describe meaningful developments of the instant invention which are neither disclosed nor made obvious in the cited art. Use of green chromium oxide pigment, aromatic modified C5 hydrocarbon resin, and aluminum paste are unobvious features of the instant invention. One of ordinary skill in the art would not have found it obvious to arrive at use of these components based on the cited references, used alone or in combination.

9. As indicated previously, claim 26 is allowed. The claim is drawn to a non-flammable composition comprised of a hydrocarbon resin, a block copolymer selected from SIS, SBS, and SEBS block copolymer(s), and a solvent system comprising about 80 % to about 99 % ethylene tetrachloride (tetrachloroethylene). Such a composition is not disclosed in the cited prior art.

#### ***Response to Arguments***

10. Applicant's arguments have been considered fully. Upon reconsideration of the claims, the examiner has concluded that they remain rejected over the cited references. Applicant's specification (page 5, paragraph [0017]) lists a series chlorinated solvents that have no flash point. As such, the solvent systems derived therefrom would be non-flammable. It follows that prior art formulations containing these solvents are also non-flammable.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rip A. Lee whose telephone number is (571)272-1104. The examiner can be reached on Monday through Friday from 9:00 AM - 5:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu, can be reached at (571)272-1114. The fax phone number for the organization where this application or proceeding is assigned is (703)872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <<http://pair-direct.uspto.gov>>. Should you have questions on the access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).

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August 31, 2005



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